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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,559	02/23/2004	William A. Pugh	BEAS-01411US1	8662
23910 7590 03/09/2007 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER VO, TED T	
			ART UNIT 2191	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/09/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/784,559

Applicant(s)

PUGH ET AL.

Examiner

Ted T. Vo

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/13/06, 12/12/06, 2/26/07</u> .                              | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is in response to the amendment filed on 12/12/2006.

Claims 6-10 are pending in the application.

### *Specification*

2. The specification of this application is filed without Drawings. Since the arrangement of the specification requires including section (h) Brief Description of the Several Views of the Drawing(s) (See MPEP § 608.01(f)), the specification should have this section with the appropriate description of its nature. It should include the header of section (h) and some statements under the header of the section (h). For example, describing drawings not applicable for the specification.

This specification is objected to because of above reasons.

The use of the trademark "Java" (JAVA or Java™) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

It should be noted that avoiding using Trademark or Trade Name as a Limitation in the Claim (Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982)).

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-10 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-4 of copending Application No. 10784600. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The amending claims of this instant application have the same mode and same effect as of the claims in the copending application.

Furthermore, there is no apparent reason why applicants would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-10 recite a system but the claims fail to particularly point out what elements/functionality of system is/are, except mixed with the steps for use by the system.

It should be noted that the Federal Circuit recently ruled that a method claim, which depended from an apparatus or system claim, was invalid under 35 U.S.C. §112, 2d para., because it mixed statutory classes. *IPXL Holdings, LLC v. Amazon.com, Inc.*, 2005 U.S. App. Lexis 25120 (Fed. Cir. 2005). Such claim is fatally flawed because it is unclear whether infringement occurs by the manufacturer making the system capable of doing the method or when the method is actually used by the user.

This type of claiming, a system, mixed with methods, is indefinite because it does not particularly point out what the system is.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2191

7. Claims 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bogle et al., US PAT. No. 6,353,923 B1.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 6: Bogle discloses **A system for debugging in more than one programming language, comprising:**

**a multi-language debugger** (See the system of FIG. 4, and the statement in col. 4:10-19, debugging a multiple language application”), where the debugger as shown in FIG. 4, covers the limitations,

**including the following capabilities:**

**providing an interface with a debugging frame for each language** (the system of FIG. 4 showing “interface” with each language engine “frame”);

**allowing a user to edit each language in a debugging frame** (any user can edit script language engines using the debug tool - see FIG. 2, the host application. Or see “debugger user interface” col. 4:29-35. Or see col. 10:57-64);

**providing the capability to interpret multiple languages within a single source file** (col. 4:19-35; particularly, see “language neutral”) **and allow each of the multiple languages to be displayed in a debugging flame;**

**providing the ability to support additional languages** (part of multiple languages); and

**wherein the multi-language debugger uses a standardize interface for a script engine** (refer to language engine such as shown in FIG. 3) **and all communications with the script engine will be through Java Debugging Interface calls to a script debug controller** (See FIG. 3).

As per Claims 7-9: Note, the limitations of claim 7-9 started by claim 7, that is claimed such as “**wherein the first breakpoint behaves like a normal break and then the following process is performed**” is indefinite. This limitation fails to be described in the claim 6, or formed as an antecedent basis.

Therefore, this claim logically fails to be as a structure of the claim 6. It is impossible to map the limitations 7-9. Accordingly, Boggle discloses

Art Unit: 2191

The system of claim 6, wherein the first breakpoint behaves like a normal break and then the following process is performed, comprising the steps of:

- a. the multi-language debugger receives the current class, line, and stack, and processes the stack through a language filter;
- b. if the multi-language debugger encounters a class that implements a script language, the debug script controller will obtain the context and the contents of the stack;
- c. script languages are processed as described in step (b), creating a stack frame list to send back to the multi-language debugger; and
- d. the multi-language debugger then proceeds to discover and inspect variables in the same way as before.

And the limitations of claims 8-9 as seen in col. 10:57-64.

As per Claim 10: The system of claim 6, wherein the script engine supports JavaScript (Script Host /Script Language Engine in FIG. 3 supports JavaScript because it associates with/uses a standard browser of Internet (description of FIG. 4, start at col. 10, line 23)).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2191

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV  
March 02, 2007



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PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100